

Remarks

Claims 1-14 are pending.

1. Rejections Under 35 U.S.C. § 103

a. Rejection Under 35 U.S.C. § 103(a) Over Greenbowe, *et al.* in view of Brenner *et al.*

Claims 1-6, 9-10 and 12 stand rejected under 35 U.S.C. § 103(a) for allegedly being unpatentable over Greenbowe *et al.* (U.S. Patent No. 5,813,865) in view of Brenner *et al.* (U.S. Patent No. 5,960,440). Applicants respectfully disagree and traverse this rejection.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. There must also be a reasonable expectation of success. See M.P.E.P. §2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In a proper obviousness determination, the changes from the prior art must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the claimed invention. See *In re Chu*, 36 U.S.P.Q.2d 1089, 1094 (Fed. Cir. 1995). This includes what could be characterized as simple changes. See, e.g., *In re*

Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down.).

Applicants submit that the Examiner has failed to present even a *prima facie* case of obviousness and has relied on a mischaracterization of the references to support his conclusion. The present invention is directed to a method for organizing laboratory procedure information in a database, comprising:

(a) defining a set of container types, wherein the container types in the set of container types each have one or more positions capable of having content;

(b) defining a set of operation types;

(c) defining a set of measurement types;

(d) performing one or more operations, wherein performing any one of the operation creates a new container with a unique identifier, and wherein the new container with a unique identifier is one of the container types in the set of container types; and

(e) performing one or more measurements, wherein performing any one of the measurements results in associating data with content in one or more of the new containers.

The Examiner alleges that “Greenbowe teaches a method for organizing laboratory procedure information, comprising...” all of the steps recited above but does not teach a database. Office Action at page 3. The Examiner, however, alleges that Brenner 440 teaches a database and that the motivation to combine is “suggested by

Brenner '440 which teaches that storing said information in the database of Brenner '440 results in superior searching and indexing capability.” *Id.* The Examiner concludes that “[I]t would have been obvious for a person having ordinary skill in the art to persist the procedure information from Greenbowe '865 in the database of Brenner '440.” *Id.* at page 2.

Initially, Applicant respectfully disagrees with the Examiner’s characterization of the art. By way of example, the Examiner asserts that “Greenbowe '865 teaches a method for organizing laboratory procedure information....” *Id.* In this regard, Applicant notes that nowhere does Greenbowe disclose or suggest a method for organizing laboratory procedure data. Greenbowe does, however, provide an apparatus and methods for teaching science and engineering to a student. In addition, the Examiner alleges that “Brenner '440 teaches a database.” *Id.* at page 3. Applicant respectfully submits that Brenner teaches a device and methods for managing kitchen information. As such, it is respectfully submitted that the Examiner’s conclusion of obviousness is based on improper reasoning and a mischaracterization of the art.

Even assuming *arguendo* that the combination is proper, the combination does not render the claimed invention obvious. Whatever else Greenbowe and Brenner disclose, they do not teach or suggest a method for organizing laboratory procedure data in a database. The Examiner has not pointed to any specific suggestion in any of the cited references that would lead one skilled in the art to combine the cited references to reach the presently claimed invention. It is impermissible hindsight to find it obvious for one skilled in the art to combine the various prior art references to reach the invention in the

present application absent some suggestion or motivation in the prior art. Therefore, it would not be obvious to one of skill in the art, from reading Greenbowe, and Brenner, that one could obtain the methods of the present invention.

Moreover, the skilled artisan would not turn to Brenner to solve the problem of organizing laboratory procedure data in a database. The Examiner alleges that Brenner is analogous art because “the system of Brenner ‘440 is directed to kitchen/cookbook recipes which are analogous to chemistry laboratory procedures....” *Id.* at page 3 “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). *See also In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992). Applicant submits that Brenner is not analogous art. First, the Brenner reference is not in the Applicant’s field of endeavor. As the Examiner points out, the Brenner reference describes improved devices and methods for managing kitchen/cookbook recipes. This is a different field of endeavor from the methods for organization laboratory procedure data of the present invention.

Nor is Brenner reasonably pertinent to the particular problem that the present inventors faced. Brenner addresses the “need for a device which contains the advantages of cookbooks, including ease of use and portability into and around the kitchen, with the advantage of cookbook programs, including recipe searching and indexing and the ability to incorporate an unlimited number of recipes from different cuisines, recipes having

different cooking skill levels and recipes from different meals.” Brenner ‘440 at col. 1, lines 43-49. A person faced with the problem of organizing laboratory data in a database would not find the teachings of Brenner pertinent.

In sum, the cited references provide no suggestion or motivation to one of ordinary skill in the art to modify the teachings of Greenbowe to arrive at the present invention. The references do not disclose or suggest a method for organizing laboratory procedure data for use in a database. As such, the cited references do not render the present claims obvious.

Accordingly, for at least these reasons, the rejection under 35 U.S.C. § 103(a) of Greenbowe in view of Brenner is improper. Applicants respectfully request withdrawal of this rejection under 35 U.S.C. § 103(a).

b. Rejection Under 35 U.S.C. § 103(a) Over Greenbowe and Brenner in View of “The Windows™ Interface, An Application Design Guide” (Microsoft ’92)

Claim 7 has been rejected under 35 U.S.C. § 103(a) for purportedly being unpatentable over Greenbowe *et al.* (U.S. Patent No. 5,813,865) and Brenner *et al.* (U.S. Patent No. 5,960,440) in view of the publication, “The Windows™ Interface, An Application Design Guide,” from Microsoft Corporation™, published by Microsoft Press, 1992 (Microsoft ’92). Office Action at page 7. For at least the reasons set forth below, withdrawal of this rejection is believed to be in order.

As argued above, Greenbowe discloses methods for teaching science and engineering to students. Brenner teaches device and methods for the management of kitchen information.

The Examiner alleges that “Microsoft ’92 teaches that each position is designated with a number.” *Id.* Regardless of what Microsoft ’92 discloses, it does not make up what Greenbowe combined Brenner lack. Therefore, for the reasons stated in the above argument, the cited references do not render the present claims obvious, since the cited references are not analogous to the present invention and there is no motivation to combine them to obtain the present invention. The cited references do not disclose or suggest method for the organization of laboratory procedure information in a database.

c. Rejection Under 35 U.S.C. § 103(a) Over Greenbowe and Brenner in View of “OLE 2™ Programmer’s Reference, Volume One” (Microsoft ’93)

Claim 8 has been rejected under 35 U.S.C. § 103(a) for purportedly being unpatentable over Greenbowe *et al.* (U.S. Patent No. 5,813,865) and Brenner *et al.* (U.S. Patent No. 5,960,440) in view of the publication, “OLE 2™ Programmer’s Reference, Volume One,” from Microsoft Corporation™, published by Microsoft Press, 1993 (Microsoft ’93). Office Action at page 8. For at least the reasons set forth below, withdrawal of this rejection is believed to be in order.

As argued above, Greenbowe discloses methods for teaching science and engineering to students. Brenner teaches device and methods for the management of kitchen information.

The Examiner alleges that “Microsoft ’93 teaches the concept and programmatic mechanism for aggregation.” *Id.* Regardless of what Microsoft ’93 discloses, it does not make up what Greenbowe combined Brenner lack. Therefore, for the reasons stated in the above argument, the cited references do not render the present claims obvious, since

the cited references are not analogous to the present invention and there is no motivation to combine them to obtain the present invention. The cited references do not disclose or suggest method for the organization of laboratory procedure information in a database.

d. Rejection Under 35 U.S.C. § 103(a) Over Greenbowe and Brenner in View of Vorhees

Claim 11 has been rejected under 35 U.S.C. § 103(a) for purportedly being unpatentable over Greenbowe *et al.* (U.S. Patent No. 5,813,865) and Brenner *et al.* (U.S. Patent No. 5,960,440) in view of Vorhees, *et al.* (U.S. Patent No. 5,946,471). Office Action at page 9. For at least the reasons set forth below, withdrawal of this rejection is believed to be in order.

As argued above, Greenbowe discloses methods for teaching science and engineering to students. Brenner teaches device and methods for the management of kitchen information.

The Examiner alleges that “Vorhees ‘471 teaches repeatability polling lab equipment in order to make measurements.” *Id.* Regardless of what Vorhees ‘471 discloses, it does not make up what Greenbowe combined with Brenner lack. Therefore, for the reasons stated in the above argument, the cited references do not render the present claims obvious, since the cited references are not analogous to the present invention and there is no motivation to combine them to obtain the present invention. The cited references do not disclose or suggest method for the organization of laboratory procedure information in a database.

e. Rejection Under 35 U.S.C. § 103(a) Over Greenbowe and Brenner in View of Rothberg

Claims 13-14 have been rejected under 35 U.S.C. § 103(a) for purportedly being unpatentable over Greenbowe *et al.* (U.S. Patent No. 5,813,865) and Brenner *et al.* (U.S. Patent No. 5,960,440) in view of Rothberg, *et al.* (U.S. Patent No. 6,190,868). Office Action at pages 11-12. For at least the reasons set forth below, withdrawal of this rejection is believed to be in order.

As argued above, Greenbowe discloses methods for teaching science and engineering to students. Brenner teaches device and methods for the management of kitchen information.

The Examiner alleges that “Rothberg teaches a method of identifying a nucleic acid sequence which includes:

- container types...
- operation types...
- measurement types...; and
- process types.....”

Id. Regardless of what Rothberg discloses, it does not make up what Greenbowe combined Brenner lack. Therefore, for the reasons stated in the above argument, the cited references do not render the present claims obvious, since the cited references are not analogous to the present invention and there is no motivation to combine them to obtain the present invention. The cited references do not disclose or suggest method for the organization of laboratory procedure information in a database.

Conclusion

In view of the above, the presently pending claims are believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections and pass the application to issue. The Examiner is encouraged to contact the undersigned at (202) 942-5085 with respect to any unresolved issues remaining in this application.

Respectfully submitted,

Date: June 3, 2004



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